



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,224	01/04/2002	Ryuji Uesugi	SHG-0201	3453

7590

04/28/2004

David T. Nikaido  
RADER, FISHMAN & GRAUER, PLLC  
Suite 501  
1233 20th Street, NW  
Washington, DC 20036

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/035,224

**Applicant(s)**

UESUGI ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) 7-14 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☐ Claim(s) 1-6 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 5/17/02 & 7/17/03.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

1. Applicant's election without traverse of claims 1-6 in the paper of 2/12/04 is acknowledged.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/73227 A1 Xue et al..

Xue discloses the instantly claimed invention at the abstract; page 1, lines 20-30; page 2, lines 18-29; page 3, lines 1-30; page 4, lines 1-28 of which line 25 falls within the scope of the instant claim 2.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 722179 A2 Wang et al..

Wang discloses the instantly claimed compositions at page 2, lines 55-57; page 3, lines 1-12; page 6, lines 45-58, of which the ether plasticizers fall within the scope of the instantly claimed high boiling solvents and the plasticizer of the instant claim 2, page 7, lines 1-25; page 9, lines 5-55, of which the amounts encompass those of the instant

claims when considered with the broader amounts recited in the prior disclosure of Wang; and the remainder of the document.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 722179 A2 Wang et al..

Wang discloses the instantly claimed compositions at page 2, lines 55-57; page 3, lines 1-12; page 6, lines 45-58, of which the ether plasticizers fall within the scope of the instantly claimed high boiling solvents and the plasticizer of the instant claim 2, page 7, lines 1-25; page 9, lines 5-55, of which the amounts encompass those of the instant claims when considered with the broader amounts recited in the prior disclosure of Wang; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients and amounts thereof in the composition of Wang because they are encompassed by Wang and would have been expected to give the properties disclosed by Wang. No unexpected results are seen stemming from the differences between the Wang reference and the instant claims in a manner commensurate in scope with the Wang disclosure and the instant claims.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (571) 272-1121. The examiner can normally be reached on Monday through Thursday from 10 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306>

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

April 27, 2004

  
Patrick Niland  
Primary Examiner  
Art Unit 1714